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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,259	08/25/2008	Guido Bold	33527-US-PCT	3223
75074 7590 07/21/2011 NOVARTIS INSTITUTES FOR BIOMEDICAL RESEARCH, INC. 220 MASSACHUSETTS AVENUE CAMBRIDGE, MA 02139				
EXAMINER PAGANO, ALEXANDER R				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
07/21/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/580,259

Applicant(s)

BOLD ET AL.

Examiner

ALEXANDER R. PAGANO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 13-24 are pending in this Application.

Election/Restrictions

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

WHEN CLAIMS ARE DIRECTED TO MULTIPLE CATEGORIES OF INVENTIONS

As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

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Restriction

Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- Group (I) claim(s) 13-16, drawn to a method of treating RET dependent disease comprising administering a compound of formula I;
- Group (II) claim(s) 17-18, drawn to species of compounds of formula I; and
- Group (III) claim(s) 21-24 drawn to method of treating a protein kinase dependent disease depending on any one or more of the protein tyrosine kinases selected from c-Abl, Bcr-Abl, Flt-3, RET, VEGF-R and/or Tek comprising administering a compound according to claims 17 or 18.

Note: Election of a single disclosed chemical compound species is required regardless of which Group is elected. Species of chemical compounds are found in the specification in the Examples section at pages 49 et seq. and listed in claim 18.

In addition, election of a single disclosed species of RET dependent disease is required if Groups (I) is elected. Species of such diseases are listed in the specification at pages 21-26

Still further, election of a single disclosed species of a protein kinase dependent disease depending on any one or more of the protein tyrosine kinases selected from c-Abl, Bcr-Abl, Flt-3, RET, VEGF-R and/or Tek is required if Groups (III) is elected. Species of such diseases are listed in the specification at pages 21-26

Lack of Unity of Invention

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

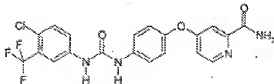
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As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to one of five enumerated combinations of categories (set forth above). For example, most relevant to the instant claims, a permitted combination of categories is "a product and process of use of said product". However, contrary to 37 CFR 1.475(b), Applicant claims comprise a product and two methods for using the product (i.e., the method of Group (I) and the method of Group (III)). As such, unity of invention is lacking between Groups (II) and (III) and restriction is proper.

Shared Technical Feature does Not Make a Contribution over the Prior Art

According to PCT Rule 13.2, unity of invention exists only when there is a shared same or corresponding special technical feature among the claimed inventions. The "Instructions Concerning Unity of Invention" (MPEP, Administrative Instructions Under the PCT, Annex B, Part 1(b)) state, "The expression 'special technical features' is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art." Thus, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the art. The technical feature that unites the groups is not a contribution over the art.

In the instant case, unity of invention is lacking between Groups (I) and (II) and between Groups (I) and (III) because even though the inventions of these groups require the common technical feature of a compound of formula I, this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of Dumas et al., WO 2003/068228 (Aug. 21, 2003) ("Dumas"). At page 36, Dumas discloses the following compound.



Dumas

Dumas's Compound falls within Applicant's compounds of formula I and therefore negates this generic formula as a special technical feature. Unity of invention is therefore lacking and restriction is proper.

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Election of Species

This application contains claims directed to more than one chemical compound species of the generic invention of Group (I) and more than one species of disease of the generic invention of Group (II). These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species do not form a single inventive concept because, as discussed above, the shared technical feature does not make a contribution over the prior art.

Applicant is required in reply to this action, regardless of which Group is elected, to elect a single chemical compound to which the claims shall be restricted if no generic claim is finally held to be allowable. Species of chemical compounds are found in the specification in the Examples section at pages 49 et seq. and listed in claim 18.

In addition, if Group I is elected Applicant must elect a single disclosed species of RET dependent disease to which the claims shall be restricted if no generic claim is finally held to be allowable. Species of such diseases/disorders are listed in the specification at pages 21-26.

Still further, if Group II is elected Applicant must elect a single disclosed species of a protein kinase dependent disease depending on any one or more of the protein tyrosine kinases selected from c-Abl, Bcr-Abl, Flt-3, RET, VEGF-R and/or Tek to which the claims shall be restricted if no generic claim is finally held to be allowable. Species of such diseases/disorders are listed in the specification at pages 21-26.

The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim.

Currently, the following claim(s) are generic to the species of chemical compounds: claims 1-16 and 19-24. The following claim(s) are generic to the species of RET dependent diseases: claims 13-16. And the following claim(s) are generic to the

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species of diseases depending on any one or more of the protein tyrosine kinases selected from c-Abl, Bcr-Abl, Flt-3, RET, VEGF-R and/or Tek: claims21-24.

Notice of Rejoinder Between Product and Process Claims

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Inventorship

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Reply and Traversal

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER R. PAGANO whose telephone number is (571)270-3764. The examiner can normally be reached on Monday through Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALEXANDER R PAGANO

Examiner, Art Unit 1624

/JAMES O. WILSON/

Supervisory Patent Examiner, Art Unit 1624

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